REMARKS

Claims 1-7, 9, and 11-20 are pending in the present application. Claims 1 and 3 have been amended. Claim 2 has been cancelled, without prejudice. Support for the amendments herein presented can be found in the specification and claims as filed. No new matter has been introduced as a result of the amendments. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

Advisory Action

In the Advisory Action dated March 31, 2003, the Examiner stated that the proposed amendments in the Response to Final Office Action raised new issues that would require further consideration and/or search and that there is no support in the specification as filed for the proposed droplet size, in fact the specification teaches away from the newly proposed range. The Applicants respectfully disagree with the Examiner.

The specification, as filed, teaches on page 7, lines 17-20 and lines 26-28, that the resulting product is a stable, homogenous, milky emulsion having an average droplet diameter less than about 10 microns, preferably ranging from about 4 to about 6 microns. The specification does not teach away from this range. The specification completely supports the amendments to Claim 1.

Reconsideration and allowance is respectfully requested in view of the amendments.

The 35 U.S.C. § 112 Rejection

Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This objection is respectfully traversed.

Claim 2 has been cancelled, and therefore this rejection is moot. Reconsideration and withdrawal of this rejection is respectfully requested.

The 35 U.S.C. § 103 Rejections

Claims 1, 3-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dubin (U.S. Patent No. 5,284,492) in view of WO 95/27021 and Schwab (U.S. Patent 5,669,938). This rejection is respectfully traversed.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 1 has been amended to recite "said emulsion having an average droplet diameter of about 6 microns to less than about 10 microns". Dubin, WO 95/27021, and Schwab do not teach an "...emulsion having an average droplet diameter of about 6 microns to less than about 10 microns." Since the cited art does not teach every element of the claimed invention, the Examiner has failed to make a *prima facie* case of obviousness.

The argument and evidence set forth above is equally applicable here. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988). Since the independent Claim 1 is nonobvious, then the dependent Claims 3-7, 9, and 11-20 must also be nonobvious.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Peter-Hoblyn et al. (U.S. Patent No. 5,743,922) in view of WO 95/27021 and Schwab. This rejection is respectfully traversed.

As stated above, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

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The argument and evidence set forth above is equally applicable here. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988). Since the independent Claim 1 is nonobvious, then the dependent Claims 3-7, 9, and 11-20 must also be nonobvious.

Reconsideration and withdrawal of this rejection is respectfully requested.

Request for Allowance

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

Dated: April 16, 2003

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